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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,401	03/25/2005	Joanne J. Fillatti	16518.145	7282
28381	7590	10/18/2007		
ARNOLD & PORTER LLP ATTN: IP DOCKETING DEPT. 555 TWELFTH STREET, N.W. WASHINGTON, DC 20004-1206			EXAMINER MCELWAIN, ELIZABETH F	
			ART UNIT 1638	PAPER NUMBER
			MAIL DATE 10/18/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/508,401

Applicant(s)

FILLATTI ET AL.

Examiner

Elizabeth F. McElwain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-72 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

The election filed August 2, 2007 is noted. However, upon further consideration of the claims the previous restriction is withdrawn and the following restriction requirement is set forth.

#### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6, 9-12, 22, 23, 25, 26, and 39-72, drawn to soybean seeds exhibiting specified altered oil composition and soybean plants that produce such seeds. If this group is selected, there is an additional election of species requirement.

Group II, claim(s) 7 and 13-21, drawn to soybean oil with increased oleic acid content and reduced saturated and polyunsaturated fatty acid content.

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Group III, claim(s) 8, drawn to soybean meal.

Group IV, claim(s) 24, drawn to feedstock.

Group V, claim(s) 31-38, drawn to a method of altering the oil composition of a plant or plant cell or seed.

Group VI, claim(s) 27-30, drawn to a transformed plant comprising a recombinant nucleic acid capable of suppressing expression of FAD2, FAD3, or FATB genes and increasing expression of beta-ketoacyl-ACP synthase I, beta-ketoacyl-ACP synthase IV or delta-9-desaturase genes. If this group is selected, there is an additional election of species requirement.

Group VII, claim(s) 39-72, drawn to recombinant nucleic acid molecules capable of suppressing expression of FAD2, FAD3, or FATB genes and increasing expression of beta-ketoacyl-ACP synthase I, beta-ketoacyl-ACP synthase IV or delta-9-desaturase genes. If this group is selected, there is an additional election of species requirement.

2. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking groups I-VII is soybean oil that exhibits an increased oleic acid content, a reduced saturated fatty acid content, and a reduced polyunsaturated fatty acid content. Martin et al teach soybean oil from a mutant soybean plant called "A5" (Plant Phys. (1986), Vol. 81, pp. 41-44). The oil from A5 has increased oleic acid content, a reduced saturated fatty acid content, and a reduced polyunsaturated fatty acid content compared to a wild-type soybean variety referred to as "Williams" (see page 43, Table IV). Therefore, the technical feature linking the inventions of groups I-VII does not constitute a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the prior art.

Accordingly, Groups I-VII are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

3. This application contains claims directed to more than one species of the generic invention of Group I, VI and VII. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species within Groups I, VI and VII are as follows:

A) suppression of expression of FAD2 and increase in expression of beta-ketoacyl-ACP synthase I

B) suppression of expression of FAD2 and increase in expression of beta-ketoacyl-ACP synthase IV

C) suppression of expression of FAD2 and increase in expression of delta-9-desaturase

D) suppression of expression of FAD3 and increase in expression of beta-ketoacyl-ACP synthase I

E) suppression of expression of FAD3 and increase in expression of beta-ketoacyl-ACP synthase IV

F) suppression of expression of FAD3 and increase in expression of delta-9-desaturase

G) suppression of expression of FATB and increase in expression of beta-ketoacyl-ACP synthase I

H) suppression of expression of FATB and increase in expression of beta-ketoacyl-ACP synthase IV

I) suppression of expression of FATB and increase in expression of delta-9-desaturase

If the Applicant elects any of Groups I, VI or VII, then the Applicant is required, in reply to this action, to elect a single species (listed as A-I, above) to

which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The technical feature linking species A-I is the use of nucleic acid constructs to inhibit the expression of one gene and increase the expression of a different gene involved in fatty acid synthesis. Chapman et al (JAOCS (2001) Vol. 78, pp. 941-947) teach a DNA construct that is effective for the suppression of the expression of an endogenous FAD2 gene (see abstract and entire document). Singh et al (Planta (2001), Vol. 212, pp. 872-879) teach the expression of an epoxygenase gene that modifies fatty acid composition (see abstract and entire document). Therefore, the

technical feature linking the species does not constitute a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the prior art.

Accordingly, species A-I are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.



5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Effective November 1, 2007, if applicant wishes to present more than 5 independent claims or more than 25 total claims in an application, applicant will be required to file an examination support document (ESD) in compliance with 37 CFR 1.265 before the first Office action on the merits (hereafter "5/25 claim threshold"). See Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications, 72 Fed. Reg. 46715 (Aug. 21, 2007), 1322 Off. Gaz. Pat. Office 76 (Sept. 11, 2007) (final rule). The changes to 37 CFR 1.75(b) apply to any pending applications in which a first Office action on the merits (FAOM) has not been mailed before November 1, 2007. Withdrawn claims will not be taken into account in determining whether an application exceeds the 5/25 claim threshold. For more information on the final rule, please see <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/clmcontfinalrule.html>.

In response to the restriction requirement set forth in this Office action, applicant is required to file an election responsive to the restriction requirement. Applicant may not file a suggested restriction requirement (SRR) in lieu of an election responsive to the restriction requirement as a reply. A SRR alone will not be considered a *bona-fide* reply to this Office action.

If applicant elects an invention that is drawn to no more than 5 independent claims and no more than 25 total claims, applicant will not be required to file an ESD in compliance with 37 CFR 1.265 that covers each of the elected claims. If the elected invention is drawn to more than 5 independent claims or more than 25 total claims, applicant may file an amendment canceling a

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number of elected claims so that the elected invention would be drawn to no more than 5 independent claims and no more than 25 total claims.

If the restriction requirement is mailed on or after November 1, 2007, applicant is also required to file an ESD in compliance with 37 CFR 1.265 that covers each of the elected claims, unless the elected invention is drawn to no more than 5 independent claims and no more than 25 total claims taking into account any amendment to the claims. To avoid the abandonment of the application, the ESD (if required) and the election must be filed within **TWO MONTHS** from the mailing date of this Office action. The two-month time period for reply is extendable under 37 CFR 1.136.

If the restriction requirement is mailed before November 1, 2007, the election must be filed within **ONE MONTH** or **THIRTY DAYS**, whichever is longer, from the mailing date of this Office action. The time period for reply is extendable under 37 CFR 1.136. Furthermore, if the elected invention is drawn to more than 5 independent claims or more than 25 total claims taking into account any amendment to the claims, the Office will notify applicant and provide a time period in which applicant is required to file an ESD in compliance with 37 CFR 1.265 covering each of the elected claims or amend the application to contain no more than 5 independent elected claims and no more than 25 total elected claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (571) 272-0802. The examiner can normally be reached on increased flex time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Elizabeth F. McElwain

Primary Examiner

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